

**REMARKS**

Applicant concurrently files herewith an Excess Claim Fee Payment Letter for three (3) excess total claims and three (3) excess independent claim and a Request for Continued Examination.

Claims 1-38 are all of the claims presently pending in the application. Claims 1-35 have been amended to more particularly define the invention. Claims 36-38 have been added to claim additional features of the invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-2, 5-7 and 9-35 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Blumberg et al. (U.S. Publication No. 2003/0140315) (hereinafter "Blumberg") in view of Basch et al. (U.S. Patent No. 6,658,393). Claims 3-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blumberg and Basch in view of Mori (U.S. Patent No. 6,089,765). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Blumberg and Basch in view of Walker et al. (U.S. Patent No. 5,970,478) (hereinafter "Walker").

**I. THE CLAIMED INVENTION**

The claimed invention, of exemplary claim 1, provides a printing pictures production system for producing a printing pictures ordered by a customer including a risk ratio calculating unit for calculating a credibility relating to a purchase of the printing pictures made

by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on the credibility, and outputting alert information when the risk ratio is above a predetermined value (see e.g., Application at page 4, lines 21-26). This allows the claimed invention to provide a printing pictures production system capable of preventing monetary damages to shops due to customers failing to pay for services (see Application at page 2, lines 7-27).

## II. THE PRIOR ART REFERENCES

### A. The Blumberg Reference

Applicants respectfully submit that Blumberg does not teach or suggest “*a risk ratio calculating unit for calculating a credibility relating to a purchase of the printing pictures made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on said credibility, and outputting said alert information when said risk ratio is above a predetermined value*” as recited in claim 1, and similarly recited in claims 17, 29, 20, 24 and 35.

The Examiner does not even allege that Blumberg teaches or suggests this feature. Indeed, the Examiner indicates that Blumberg “fails to teach a risk ratio calculating unit for calculating a credibility relating to a purchase of the printing pictures made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on said credibility, and outputting said alert information when said risk ratio is above a predetermined value” (see Office Action dated June 1, 2005 at page 4). Therefore, the Examiner clearly concedes that Blumberg does not teach or suggest this feature.

**B. The Basch Reference**

The Examiner alleges that Basch would have been combined with Blumberg to teach the claimed invention of claims 1, 2, 5-7 and 9-35. Applicants respectfully submit, however, that these references would not have been combined as alleged by the Examiner and that, even if combined, the alleged combination would not teach or suggest each and every feature of the claimed invention.

That is, the Examiner's alleged motivation to modify Blumberg ("to prevent providing goods and services to account holder with high risk of default and/or low credibility") is not a problem in Blumberg that would require a solution. Thus, as pointed out in MPEP §2143.01 the Examiner's motivation is "improper". That is, *"the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination"* (emphasis in MPEP itself).

Furthermore, Applicants respectfully submit that Blumberg and Basch are clearly nonanalogous art. In the Response to Arguments section of the Office Action, the Examiner alleges that Blumberg and Basch are analogous because Blumberg and Basch are in the same field of endeavor. Specifically, the Examiner alleges that Blumberg and Basch are both related to a "business method" (see Office Action dated November 10, 2005 at pages 10-11). The Examiner, however, is clearly incorrect.

Applicants respectfully submit that Blumberg and Basch are clearly nonanalogous art. That is, the Examiner's allegation that the field of endeavor of Blumberg and Basch is a "business method" is erroneous. Indeed, Blumberg is directed to an on-line printing service that enables a user to interactively create and view a document prior to printing the document (see Blumberg at paragraph [0009]). Blumberg clearly states that the "present invention relates to computerized print on demand services" (see Blumberg at paragraph [0001]).

In stark contrast, Basch is specifically directed to a method for predicting financial risk (see Basch at Abstract). Basch is directed to minimizing financial losses to account holders (see Basch at column 3, lines 35-40). Basch has nothing at all to do with on-line printing services. Indeed, Basch clearly discloses that the “present invention relates to financial risk prediction systems” (see Basch at column 1, lines 15-16).

The Examiner’s overly broad assertion that any and all patents related to a “business method” are analogous art is clearly incorrect.

Furthermore, Basch does not address the problems faced by the on-line printing service disclosed in Blumberg. Therefore, one of ordinary skill in the art would not have been motivated to modify the on-line printing service disclosed by Blumberg with the financial risk predicting method disclosed by Basch. Thus, the references would not have been combined, absent hindsight.

Moreover, neither Blumberg, nor Basch, nor any combination thereof, teaches or suggests “*a risk ratio calculating unit for calculating a credibility relating to a purchase of the printing pictures made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on said credibility, and outputting said alert information when said risk ratio is above a predetermined value*” as recited in claim 1, and similarly recited in claims 17, 29, 20 and 24.

Indeed, as indicated in section A above, the Examiner concedes that Blumberg does not teach or suggest this feature. Furthermore, Applicants submit that Basch does not make up the deficiencies of Blumberg.

The Examiner attempts to rely on Figure 1, column 6, lines 42-65 and column 18, lines 37-39 of Basch to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor these passages (nor anywhere else for that matter)

does Basch teach or suggest a risk ratio calculating unit for calculating a credibility relating to a purchase of the printing pictures made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on the credibility, and outputting alert information when the risk ratio is above a predetermined value. Indeed, Basch merely teaches a financial risk prediction system.

The claimed invention teaches calculating a credibility relating to a purchase of the printing pictures. In stark contrast, Basch merely teaches a system for predicting a financial risk based on a consumers past credit. However, the predicted risk is not calculated in specific relation to the purchase of the printing pictures made by the customer.

Thus, Basch fails to make-up for the deficiencies of Blumberg.

Therefore, Applicants respectfully submit that these references would not have been combined as alleged by the Examiner and that, even if combined, the alleged combination would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **C. The Mori Reference**

The Examiner alleges that Mori would have been combined with Blumberg and Basch to teach the claimed invention of claims 3 and 4. Applicants respectfully submit, however, that these references would not have been combined as alleged by the Examiner and that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, neither Mori, nor Blumberg, nor Basch, nor any combination thereof, teaches or suggests “*a risk ratio calculating unit for calculating a credibility relating to a purchase of the printing pictures made by the customer from information relating to the customer*

*associated with customer identification information, calculating a risk ratio based on said credibility, and outputting said alert information when said risk ratio is above a predetermined value” as recited in claim 1, and similarly recited in claims 17, 29, 20 and 24.*

Indeed, the Examiner attempts to rely on Figure 1 and columns 2-4 of Mori to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor this passage (nor anywhere else for that matter) does Mori teach or suggest a risk ratio calculating unit for calculating a credibility relating to a purchase of the printing pictures made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on the credibility, and outputting alert information when the risk ratio is above a predetermined value. Indeed, the Examiner does not even allege that Mori teaches or suggest this feature. The Examiner merely attempts to rely on Mori as teaching an order information storing unit that has order expiry date information defining a term to store order information.

Thus, Mori fails to make-up the deficiencies of Blumberg and Basch.

Moreover, regarding the Examiner’s rejection of claims 3 and 4, Applicants respectfully submit that Mori would not have been combined with Blumberg and Basch, as alleged by the Examiner. That is, the Examiner is merely going to a “parts bin” and selectively “picking and choosing” features of the applied references to arrive at the claimed invention. This, the Examiner is prohibited from doing.

That is, the Examiner’s alleged motivation to modify Blumberg and Basch ( because “deleting reserved print order at predetermined amount of time to allocate memory space if the expiration date or print order is not extended”) is not a problem in Blumberg and Basch that would require a solution. Thus, as pointed out in MPEP §2143.01 the Examiner’s motivation is “improper”. That is, “*the mere fact that references can be combined or modified does not*

*render the resultant combination obvious unless the prior art also suggests the desirability of the combination”* (emphasis in MPEP itself).

Therefore, Applicants respectfully submit that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

#### **D. The Walker Reference**

The Examiner alleges that Walker would have been combined with Blumberg and Basch to teach the claimed invention of claim 8. Applicants respectfully submit, however, that these references would not have been combined as alleged by the Examiner and that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, neither Walker, nor Blumberg, nor Basch, nor any combination thereof, teaches or suggests “*a risk ratio calculating unit for calculating a credibility relating to a purchase of the printing pictures made by the customer from information relating to the customer associated with customer identification information, calculating a risk ratio based on said credibility, and outputting said alert information when said risk ratio is above a predetermined value*” as recited in claim 1, and similarly recited in claims 17, 29, 20 and 24.

Indeed, the Examiner attempts to rely on Figure 1 and columns 2-4 of Walker to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor this passage (nor anywhere else for that matter) does Walker teach or suggest a risk ratio calculating unit for calculating a credibility relating to a purchase of the printing pictures made by the customer from information relating to the

customer associated with customer identification information, calculating a risk ratio based on the credibility, and outputting alert information when the risk ratio is above a predetermined value. Indeed, the Examiner does not even allege that Walker teaches or suggest this feature. The Examiner merely attempts to rely on Walker as teaching calculating a risk ratio at the time of producing the product.

Thus, Walker fails to make-up the deficiencies of Blumberg and Basch.

Moreover, regarding the Examiner's rejection of claim 8, Applicants respectfully submit that Walker would not have been combined with Blumberg and Basch, as alleged by the Examiner. That is, the Examiner merely appears to be picking and choosing features of the applied references to arrive at the claimed invention.

That is, the Examiner's alleged motivation to modify Blumberg and Basch ("to prevent faulty purchase by an individual with bad/poor purchase history") is not a problem in Blumberg and Basch that would require a solution. Thus, as pointed out in MPEP §2143.01 the Examiner's motivation is "improper". That is, *"the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination"* (emphasis in MPEP itself).

Furthermore, Applicants respectfully submit that Walker and Blumberg/Basch are not analogous art. That is, the Examiner merely alleges that Walker is in the same filed of Endeavor as Blumberg and Basch. The Examiner, however, is clearly incorrect.

That is, Blumberg is clearly relate to an on-line printing service that enables a user to interactively create and view a document prior to printing the document (see Blumberg at paragraph [0009]). Blumberg clearly states that the "present invention relates to computerized print on demand services" (see Blumberg at paragraph [0001]).

In stark contrast, Walker is merely directed to a method for customizing credit



accounts (see Walker at Abstract). Walker clearly states that it is directed to “a method, apparatus, and program for modifying the terms of existing credit accounts to meet specific customer needs” (see Walker at column 1, lines 5-9).

Furthermore, Walker does not address the problems faced by the on-line printing service disclosed in Blumberg. Therefore, one of ordinary skill in the art would not have been motivated to modify the on-line printing service disclosed by Blumberg with the method for customizing credit accounts disclosed by Walker. Thus, the references would not have been combined, absent hindsight.

Therefore, Applicants respectfully submit that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **III. NEW CLAIMS**

New claims 36-38 have been added to provide more varied protection for the claimed invention and to claim additional features of the invention. These claims are independently patentable because of the novel features recited therein.

Applicants respectfully submit that new claims 36-38 are patentable over any combination of the applied references at least for analogous reasons to those set forth above with respect to claims 1-35.

### **IV. FORMAL MATTERS AND CONCLUSION**

In view of the foregoing, Applicants submit that claims 1-38, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are

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in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

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Respectfully Submitted,



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